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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,143	09/10/2001	Haruhiko Hirose	P100158-00043	9383

7590 01/14/2004
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WASHINGTON, DC 20036-5339

EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/926,143

Applicant(s)

HIROSUE ET AL.

Examiner

Kevin R Kruer

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.Claim(s) objected to: NONE.Claim(s) rejected: 1-13.Claim(s) withdrawn from consideration: NONE.

8. ☒ The drawing correction filed on 9/10/2001 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

The proposed amendment filed December 8, 2003 will not be entered because it fails to place the application in better form for appeal by materially reducing and/or simplifying the issues for appeal. The amendments fail to distinguish the claims from the applied art. Furthermore, the proposed amendment will not be entered because they raise new issues that would require further search and/or consideration.

Specifically, the "space on the side of the pressing die surrounded by the polyimide film and an inner surface of the die plate" has not previously been claimed. The bending of the polyimide was also not previously specified to be "an initial stage" process and the "depressurizing and pressurizing" was not previously specified to be "a final stage" process.

Applicant's arguments have also been fully considered but are not persuasive. Applicant argues that Anthony in view of Sado fails to render the pending claims obvious because the mold taught in Anthony comprises a large number of projections wherein the claims are directed to a concave surface. The examiner initially notes that the mold in Anthony may have any convenient configuration (col 3, lines 3+). Furthermore, the examiner notes that Sado, not Anthony, was relied upon to motivate one of ordinary skill in the art to utilize a concave mold. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that the deformation taught in Anthony is a result of suction rather than pressurization of the gas. The examiner respectfully disagrees. Anthony teaches that the elevation of pressure in the autoclave (abstract) and the suction of air from between the sheet and the die (col 3, lines 10+) reads on Applicant's claimed "simultaneously depressurizing and pressurizing" limitation.

The present invention is distinguished from Anthony, according to applicant, because the polyimide never touches the molding surface until the last moment. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the contacting of the polyimide to the molding surface at the last moment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that the claimed method results in unexpected improvements. Specifically, the claimed method is said to result in polyimide sheets free of surface defects. However, Applicant has failed to compare the claimed invention to the closest prior art (the method taught by Anthony). Thus, Applicant's arguments are not persuasive.

According to applicant, the autoclave taught in Anthony fails to read on the claimed pressing die. The examiner respectfully disagrees. The autoclave meets applicant's requirement that the die covers the open end of the molding die (paragraph 22 of the specification). Said autoclave also meets Webster's Dictionary definition of a

die—"a device for imparting a desired shape, form, or finish to a material or for impressing an object or material."

Sado is drawn to a press stretching method. Applicant argues that such a method is not analogous to the claimed method. However, Sado was not relied upon to teach the method by which the polyimide film is formed. Rather, Sado was relied upon to teach the desirability of forming polyimide into a concave shape. The examiner, therefore, maintains that Sado would have motivated one of ordinary skill in the art to utilize a concave mold with the method taught by Anthony.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

K-RK

Kevin R. Kruer
Patent Examiner-Art Unit 1773

Paul Thibodeau
Paul Thibodeau
Supervisory Patent Examiner
703-308-2367